

Docket No.: 3350-05G
File No. 1158.41315CC6
Client No.: Ebill-G

PATENT

REMARKS

Claims 34-52 are pending in this application.

Claims 34, 42, and 49 are independent.

Claim 39, 46, 49, and 51 amended herein in a non-narrowing manner to correct minor editorial errors.

Claims 34-41 and 49-52 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The rejection is respectfully traversed.

Each of the rejected claims is directed to generating a user authorization of payment of electronically presented bills, or electronically presenting bill related information. As discussed in AT&T Corp. v. Excel Communications Inc., 50 USPQ 2nd. 1447 (Fed. Cir. 1999) [quoted in Ex Parte Bowman], processes which are "electronic, chemical, or mechanical" are within the technological art or environment (see Ex Parte Bowman, at 1671).

Accordingly, to the extent that the two-prong test is still valid, it is respectfully submitted that the present claims meet both prongs of the test. That is, the claims recite a disclosed invention which is well grounded in an area of the technological arts (i.e., the electrical arts) [see Ex Parte Bowman, 61 USPQ 2nd. at 1674] and, as acknowledged by the Examiner, clearly recite useful, concrete and tangible results. Therefore, it is respectfully requested that the rejection be reconsidered and withdrawn.

Claims 34-52 stand rejected under the judicially created doctrine of obviousness-type doubling patenting over claims 1, 3-6, 8 and 34-57 of co-pending Application Serial Number 09/795,314. The rejection is respectfully traversed.

Docket No.: 3350-05G
File No. 1158.41315CC6
Client No.: Ebill-G

PATENT

Each of the cited claims of the '314 application requires either receipt of a request for available bills, or transmission of at least one notice of availability of a bill or bill presentment information. Claims 34-52 lack any recitation relating to such features.

Furthermore, each of claims 34-52 recite features, such as a payment authorization indicator or message, which are entirely lacking in the cited claims of the '314 application.

Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Claims 34-52 stand rejected under the judicially created doctrine of obviousness-type doubling patenting over claims 1-19 of U.S. Patent Number 6,289,322. The rejection is respectfully traversed.

Each of the cited claims of the '322 patent requires receipt of a request for current billing information. Claims 34-52 lack any recitation relating to such a feature.

Furthermore, each of claims 34-52 recite features, such as a payment authorization indicator or message, which are entirely lacking in the cited claims of the '322 patent.

Accordingly, it is respectfully requested that the rejection be reconsidered and withdrawn.

Claims 46 and 51 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner's noted concerns regarding claim 51 have been addressed by the present amendment. The rejection of claim 46 is respectfully traversed.

The Examiner argues that claim 46 does not "positively recite the authorization of the payment." The Examiner's position is not understood, as claim 46 clearly and unequivocally requires that a processor generate a message to authorize payment. It is respectfully submitted that the claim is definite: a payment authorization message is generated by a

Docket No.: 3350-05G
File No. 1158.41315CC6
Client No.: Ebill-G

PATENT

processor. Accordingly, it is courteously requested that the Examiner reconsider and withdraw the 35 U.S.C. §112, second paragraph rejection of claim 46.

Claims 34-52 stand rejected under 35 U.S.C. §103(a) as obvious over Hogan (U.S. Patent No. 5,699,528). The rejection is respectfully traversed.

Hogan discloses two embodiments of an electronic bill presentation service. In both embodiments, a bill image is received from a biller and formatted for presentation (see, for example, column 4, lines 53-67, column 5, lines 53-57, and column 9, lines 50-53). In the first embodiment, a subscriber retrieves the stored billing information from the bill service via the World Wide Web (see, for example, column 2, lines 32-35, and Figure 4), and in the second embodiment, the stored billing information is transmitted to the subscriber as an e-mail message by the bill service (see, for example, column 2, line 48-50, and Figure 11).

Independent claims 34 and 42 require, inter alia, a display on a single screen of information associated with a first bill and a second bill, user input of a selection of at least one of the displayed first and second bill, and generation of a single payment authorization message based upon the user input. Independent claim 49 requires, inter alia, a single screen for electronically presenting bill related information, the single screen including at least user selectable information corresponding to a first bill and user selectable information corresponding to a second bill, and at least one payment authorization indicator which can be activated by a user to authorize payment.

The Examiner relies upon Figures 2B, 10, and 11 in rejecting the independent claims. Figure 2B is associated with the first (Web-based) embodiment of Hogan. The processing of Figure 2B is described beginning at column 6, line 10. With particular

Docket No.: 3350-05G
File No. 1158.41315CC6
Client No.: Ebill-G

PATENT

reference to column 6, lines 20-45, whenever a user selects a "receive and pay bills" choice (detail 203) from the user interface of Figure 3, a first unopened electronic bill is presented to the user, as shown in Figure 4. Figure 2B, nor associated Figures 3 and 4, does not teach, nor does it suggest, a single screen display of two or more electronic bills. Rather, these Figures, and associated text, only teach display of a single bill on a screen. Thus, the claims of the instant application cannot be anticipated by, or obvious in view of, Figure 2B.

Figures 10 and 11 are associated with the second (e-mail) embodiment of Hogan. Figure 10, described beginning at column 10, line 52, discloses an email presentation including information representing multiple electronic bills. Figure 10 does not include any sort of payment authorization information. Rather, as described in column 10, line 65, through column 11, line 9, a user selects information representing an electronic bill included in Figure 10, then the electronic bill is presented to the user, as shown in Figure 11. Figure 11 represents a single, not multiple, electronic bill. The user may, as shown in Figure 11, authorize payment of the single electronic bill. Thus, Figure 10 is merely a listing of bills, and Figure 11 is a presentation of a single one of the bills listed in Figure 10.

Neither Figure 10 nor Figure 11 teaches or suggests receipt of a user input that includes both a payment authorization and selection of at least one of first and second bill information displayed together, as required by independent claim 34; generation of a single message authorizing payment of at least one of a first bill and a second bill displayed together based upon a received user input selecting at least one of the first bill and the second bill, as required by independent claim 42; or a single screen presenting selectable information representing a first bill, selectable information representing a second bill, and a

Docket No.: 3350-05G
File No. 1158.41315CC6
Client No.: Ebill-G

PATENT

payment authorization indicator, as required by independent claim 49.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the rejection of independent claims 34, 42, and 49, as well as the respective dependencies of the independent claims.

The dependent claims of the present application recite further features that are both novel and unobvious. For example, claims 35 and 43 require display of information associated with a third bill, user input selecting first bill and second bill, but not third bill, information, and the generated single message authorizing payment of the first and second bills, but not the third. And, claim 50 requires the single screen to display information associated with a third bill, and that the payment authorization indication can be activated to authorize payment of multiple bills.

The Examiner acknowledges that Hogan does not teach the requirements of claims 35, 43, and 50. However, the Examiner takes Official Notice that "it is old and well known in bill consolidation to authorize the payment of more than one bill at the time in order to save transaction time. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a single message authorizing the payment of the first and second bill in order to obtain the above mentioned advantage."

It is respectfully submitted that invention recited in claims 35, 43 and 50 is not 'old and well known'. Thus, it is respectfully requested that the Examiner cite and properly apply prior art that teaches the features for which Official Notice has been taken.

Claim 38 requires the payment authorization to be one of a full payment amount authorization or a minimum payment amount authorization. Claims 39, 46, and 51 require display of a full payment amount authorization indicator and a minimum payment amount

Docket No.: 3350-05G
File No. 1158.41315CC6
Client No.: Ebill-G

PATENT

indicator. The Examiner looks to Figure 4, item 411, for such features. The Examiner's reliance upon detail 411 is not understood, as detail 411, while disclosing a full payment amount authorization and indicator and a partial payment amount authorization and indicator, does not disclose a minimum payment amount authorization or indicator. The description of detail 411, found in column 6, lines 55-65, is clear that a user may authorize a full payment amount, or a partial payment amount if the bill is an installment bill. Figure 4 simply does not disclose the requirements of any of claims 39, 46, or 51 regarding minimum payment amounts.

Claims 40 and 47 require the multiple bills to be of a particular bill type. Claims 41 and 48 require the user selection to be, *inter alia*, a selection of a particular bill type. Claim 52 requires the single screen display to include a particular bill type indicator and that the multiple bills be of an indicated type.

The Examiner looks to Figure 10 for these features. Figure 10 shows three bills, an insurance bill, a utility bill, and a retail bill. These three bills are not of a same particular type. Further, the only information conveyed by Figure 10 is payee name information, bill amount information, and due date information. There simply is no indication of a bill type in Figure 10, or any other portion of Hogan. Thus, the Examiner's reliance upon Figure 10 in rejecting these claims is not understood.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or

Docket No.: 3350-05G
File No. 1158.41315CC6
Client No.: Ebill-G

PATENT

suggestions arise in connection with the application.

The Official Action (paper number 18) to which this Amendment is responsive was faxed to applicants' representative by the Examiner on March 26, 2004 in response to a request by applicants' representative. The United States Patent and Trademark Office's November 25, 2003 mailing of the Official Action has yet to reach applicants' representatives. According to MPEP §707.13 (which applies Ex parte Gourtoff), if delivery of an Official Action fails, the Official Action should be remailed to the applicant (or representative) and the time period for reply to said Official Action should be restarted. Thus, in view of MPEP §707.13 and Ex parte Gourtoff, this Amendment is being filed within three months of issuance of an Official Action and no extension of time should be necessary. However, to the extent that it is determined that a petition for an extension of time is necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-0429 and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Sterling W. Chandler
Registration No. 51,370

1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209
Tel.: 703-312-6600
Fax.: 703-312-6666

SWC